

Appl. No. : 10/616,015  
Filed : July 9, 2003

## REMARKS

In response to the Office Action mailed June 14, 2005, please reconsider the above-captioned application in light of the above amendments and the following remarks.

### Claims 20 to 27 Are Currently in Condition for Allowance

The Examiner rejected Claims 20-27 under 35 U.S.C. Sections 102(b) and 103(a) in light of U.S. Patent No. 122,030 to Kelleher, et al. Applicant has amended independent Claim 20 to clarify the claim language and to distinguish over Kelleher. Applicant contends that Claim 20 and Claims 21-27, which depend therefrom, are currently in condition for allowance.

Kelleher teaches boots and shoes that are made from sewn-together flat pattern cut-outs. Kelleher's inventive focus was to cut the patterns so that they could be sewn together by machinery instead of by hand. (Col. 1, lns. 14-16.)

Kelleher's boot (see FIGS. 1-6) includes a front leg A and a back leg B that are attached to each other along seams. More specifically, the front and back leg sections overlap, and two flat seams are stitched in two rows to connect the front and back legs A, B. As stated by Kelleher, “the principal benefit is found in the fact that the seams can be made flat and stitched by machinery, thus avoiding all hand-work.” (Col. 1, lns. 43-45.) Similarly, the bottom edges of the leg portions A, B are attached to a top edge of the quarter C by two rows of stitches making a flat seam. Again, it is important that “both of these seams [can] be stitched by machinery.” (Col. 1, lns. 50-51.) This same pattern is used for all of the seams, including all of the seams of the shoe depicted in Figures 8-12. Kelleher refers to such a flat seam as a “lap-seam,” and notes that in accordance with his invention, such flat lap-seams are used exclusively. (Col. 2, ln. 46.) This is especially beneficial, in Kelleher’s eyes, because such lap-seams can be sewn by a machine, rather than by hand, thereby reducing the cost of manufacturing. (Col. 2, lns. 49-51.)

As discussed in the specification, Kelleher’s lap-seams are all overlapping and substantially flat so as to be easily sewn by machine. Kelleher makes no indication that the adjoining edges are bent or deformed in any way. Rather the teaching is that the seams are flat. Further, close inspection of Figures 1 and 8, which correspond to the boot and shoe embodiments, do not give any indication that the relevant seams are biased or deformed inwardly during manufacture.

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Claim 20 has been amended and currently recites a method of making a skate boot upper comprising, *inter alia*, providing a quarter panel having a curved ankle edge forming a first curvature, providing an ankle support panel having a curved lower edge, the curved lower edge forming a second curvature that is not complementary to the first curvature, deforming at least one of the edges in a direction generally transverse to the edge so that the first and second curvatures generally correspond to one another, and joining the edges so that the joined edges are biased inwardly. At least these limitations are not taught or suggested by Kelleher. In fact, Kelleher's flat lap-seams teach against these limitations. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of this claim.

Claim 22 additionally recites a lateral and medial quarter panel, the medial quarter panel having a curved ankle edge forming a third curvature, and that the third curvature is different from than the first curvature. The Examiner contends, "Since the curvature of the quarter panels needs to match up with that of the ankle support panels, it would have been obvious . . . to make the curvature of the panels to match so as to be able to easily connect to each other, i.e. the edges being complimentary." (Office Action, ¶ 6.) Applicant notes that the first and third curvatures correspond to edges of the lateral and medial quarter panels, respectively. These edges do not match up with each other, but are intended to be connected to the corresponding ankle support panels. Accordingly, the Examiner's conclusion does not follow, because the first and third curvatures do not have any alignment relationship. Employing non-matching first and third curvatures enables versatility in skate boot design, and enables features such as having a different shape of biasing on a medial side of the boot than on a lateral side of the boot. These features and the claimed limitation were not considered by Kelleher and are not taught or suggested by Kelleher. Accordingly the Applicant respectfully requests that the Examiner withdraw the rejection of this claim.

Claim 26 depends from Claim 20 and additionally recites a heel counter stiffener having an upper edge that is generally aligned with the quarter panel curved ankle edges, and providing a contour seam configured so that the upper edge is biased generally inwardly. The Examiner rejected this claim as unpatentable over Kelleher in view of U.S. Patent No. 5,784,809 to McDonald. Applicant respectfully traverses the rejection, and disagrees with the Examiner's characterization of the prior art. First of all, the Examiner contends that Kelleher teaches

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"providing a counter seam configured so that the upper edge is biased generally inwardly." (Office Action, ¶ 7.) As discussed above, Kelleher teaches no such biasing.

McDonald teaches a snowboard boot. The Examiner contends that a heel counter 32 is aligned with the quarter panel (presumably the "leather portion 31") as shown in Figure 1. The Examiner further contends that this alignment provides a seam that is biased generally inwardly, and is illustrated by Figures 2 and 3. First, Applicant respectfully disagrees with the Examiner's characterization of the heel counter 32 and leather portion 31 as involving any kind of stiffener member. Or indicating any kind of inward bias. In fact, Figure 2 includes several lines to show the curvature of the boot. These lines show the curvature as continuous, and show that there is no biasing at all, particularly at the intersection of the heel counter 32 and the leather portion 31. The combination of Kelleher and McDonald simply does not teach or suggest the limitations recited in Claim 26. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of this Claim.

#### New Claims

New Claims 35-51 have been added to more thoroughly claim the subject matter Applicant considers to be the invention. New Claims 35 and 36 depend from allowable Claim 20 and recite additional patentable subject matter. New Claim 37 is an independent claim from which new Claim 38-51 depend. These new claims are appropriately included in Species III as defined in the Office Action mailed by the Office on February 25, 2005, which species was elected by the Applicant. Specifically, independent Claim 37 relates to a method including joining a quarter panel to an ankle portion along curved edges. This subject matter falls squarely within the definition of Species III as set out by the Examiner. Dependent Claims 38-51 depend from Claim 37 and recite additional patentable subject matter.

No new subject matter has been added by the new claims, and Applicant respectfully contends that all of the new claims are currently in condition for allowance.

#### **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

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The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,

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